Appl. No. 09/636,039
Amdt. dated March 6, 2008
Reply to Office Action of September 7, 2007

PATENT

REMARKS/ARGUMENTS

Claims 11-19, 30-38 and 40-44 are currently pending.

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Reconsideration of the claims in view of the amendments above and the arguments below is respectfully requested.

Priority Claim to Parent Application

In the "Response to Arguments" section of the Office Action, the Examiner has asserted that not all of the limitations of the independent claims are supported by the parent application. Applicants submit that all of the claim limitations in the independent claims are supported by the parent application U.S. Patent Application No. 08/995,616 filed December 22, 1997 for at least the reasons discussed below. Applicants consequently submit that the Acrobat Reader reference (published 1999) and the Nathan reference (U.S. Patent No. 6,326,957 to Nathan et al. issued December 4, 2001) are not valid prior art references since the parent application predates these references.

In particular, the Office Action indicates that the Examiner could not find support in the parent application for the following claim language recited in claim 11:

dynamically changing the contents of the single thumbnail image to reflect a change in the contents of the document displayed in the first viewing area;

Applicants respectfully submit that support for the above-recited features and for all of the features recited in the pending independent claims can be found in the parent application.

The Examiner indicated that no basis could be found in the parent application for this feature of claim 11. Specifically, the Examiner indicated that the idea of dynamically updating a document with annotations is discussed at only one in the parent application: page 6, line 26-page 7, line 6: "The processing of annotation agent 508 is preferably a run-time process. The annotations are not preferably pre-inserted into the text but are rather generated when user 504 requests document 502 for browsing." The Examiner has also indicated that the only discussion of the idea that the thumbnail includes annotations can be found at page 12, lines 9-11 of the parent application: "Elongated thumbnail image 214 provides a convenient view of the

basic document 10 structure. The annotations incorporated into the document are visible within elongated thumbnail image 214."

Applicants submit that the parent application provides support for dynamically updating of annotations in a document. Annotations are generated at the time that a user selects a document for browsing, as indicated by the passage of the specification cited by the Examiner (page 6, line 26-page 7, line 6). However, the generation of annotations in the document is not merely limited to when the user selects a document for browsing. The annotations depend upon the user's selection of concepts of interest and these selections may be updated as the user is browsing the document. Specification at page 7, lines 7-13. A series of concept checkboxes are included in the user interface that allow the user to select which concepts are of interest to the user and to adjust the sensitivity of the to apply when identifying potentially relevant locations within the document. Specification at page 4, lines 18-22. For example, the user may select a word or phrase in the document as being relevant to a particular concept of interest even though the word or key phrase has not yet been defined to be a keyword or key phrase.

The user may also change the perceived level of relevance of an existing keyword or key phrase. The relationships between concepts and keywords is modifiable *during* use of the annotation system. These modifications may be made through explicit user feedback, such as that described above, or may automatically be performed in the background. As a result of these modifications, probability values used for determining relevant being changed, the introduction of new connections between subconcepts and concepts, or the introduction of new keywords or key phrases. Specification at page 9, lines 5-24. The annotations within the document are based upon the level of relevance to the user of various concepts present in the document. If the user changes the level of relevance of keywords or key phrases and the annotations were not regenerated in response to these changes, the annotations would likely no longer correspond to areas of the document that are of interest to user. Accordingly, Applicants respectfully submit that dynamically updating of the annotations is supported by the parent application.

Applicants further submit that the parent application does provide support for dynamically updating the annotations in within the thumbnail image as recited in claim 11. The thumbnail image provides a view of the basis document structure, including annotations.

Annotations added to the document are reflected in the thumbnail image, facilitating users to quickly identify relevant text anywhere within the document. Specification at page 13, lines 3-5. If the annotations are dynamically updated in the document as described above, the corresponding annotations displayed in the thumbnail image are also updated. Otherwise, if the annotations in the document changed and the displayed annotations in the thumbnail image were not updated, the annotations displayed in the thumbnail image would no longer correspond to the annotations found within the document, and a user would not be able to rely upon the thumbnail image to find relevant text within the document.

Therefore, Applicants submit that each of the features recited in independent claim 11 is fully supported by the parent application. Applicants further submit that independent claims 19, 30, 38, 40 and 41 are also fully supported by the parent application for at least the same reasons as claim 11.

Accordingly, Applicants submit that Acrobat Reader and Nathan are not valid references for at least independent claims 11, 19, 30, 38, 40 and 41, because the parent application predates both Acrobat Reader and Nathan.

Rejections under 35 U.S.C. 103

Claims 11-14, 17, 18, 30-33, 36, 37 and 40

Claims 11-14, 17, 18, 30-33, 36, 37 and 40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Adobe Acrobat Reader, published 1999 (hereinafter "Acrobat Reader") and in view of U.S. Patent No. 5,546,502 to Hart et. al (hereinafter "Hart") and in further view of U.S. Patent No. 6,326,957 to Nathan et al. (hereinafter "Nathan").

Applicants submit even if the pending claims were not fully supported by the parent application (which they are), the cited references fail to teach each of the features recited in the pending independent claims.

For example, claim 11, as amended, recites, in part "dynamically changing the contents of the single thumbnail image *to reflect a change in the contents of the document in the first viewing area*" of a display (emphasis added).

The Office Action admits on page 4, second paragraph that neither Acrobat Reader "dynamically changing the contents of the single thumbnail image to reflect a change in the contents of the document" as recited in independent claim 11. The Office Action however asserts that Nathan teaches this feature of claim 11. Applicants respectfully disagree.

Applicants submit that Nathan merely discloses systems and methods for displaying page information in a handwriting recording device such as a personal digital notepad ("PDN") device. See Nathan, Abstract. The Office Action relies upon the "dynamic icons" disclosed in Nathan to teach "dynamically changing the contents of the single thumbnail image" feature recited in claim 11. However, Applicants submit that the "dynamic icons" described in Nathan do not dynamically change their contents "to reflect a change in the contents of the document in [a] first viewing area" of a display as recited in claim 11.

Applicants submit that the dynamic icons of Nathan merely represent a page of handwritten text that has been captured by a personal digital notepad (PDN) device. The PDN includes an electronic stylus having an inking tip that enables a user to write on a piece of paper placed over a digitizing tablet portion of the PDN and the digitizing tablet portion of the PDN captures the strokes of the user's handwriting. The user's handwriting captured by the PDN device is referred to as "digital ink." Nathan, col. 1, lines24-29.

The PDN device includes a small LCD panel embedded in the device that may be used to display a "dynamic icon." The dynamic icon is a small thumbnail image that provides a rough approximation of the ink structure of a page of digitally captured handwriting. The PDN device is operable in a thumbnail display mode, and when a user switches the PDN device to thumbnail display mode, a thumbnail image representing a page of captured handwriting stored in the memory of the PDN is displayed on the LCD panel. The thumbnail image is generated from recorded positional data representing the digital ink for a selected page of handwriting stored in memory. See Nathan, col. 5, lines 37-50. The PDN device may store multiple pages of handwritten data in memory, and the user may browse through these pages. When the user selects a different page of handwritten data stored in memory, the thumbnail image is updated to display a rough approximation of the next page of handwriting stored in memory. See Nathan, col. 5, lines 37-50.

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Applicants submit that Nathan fails to teach or suggest at least "dynamically changing the contents of the single thumbnail image *to reflect a change in the contents of the document in the first viewing area*" as recited in claim 11. The Office Action relies upon col. 6, lines 14-18 to teach this feature of claim 11. The cited portion of Nathan merely provides that the "the thumbnail representation of a digital page may be dynamically displayed, whereby the displayed thumbnail is continually updated as the user writes on the page." Nathan, col. 5, lines 14-18. Merely updating the dynamic icon as the user writes on the digitizing tablet portion of the PDN is not the same thing as dynamically changing the contents of a thumbnail image in response to a change in the contents of a document "in the first viewing area" as recited in claim 11. As described above, the dynamic icon is merely a representation of a set of positional data (col. 5, line 43) recorded as the user writes using a special inked stylus on a piece of paper placed over the digitizing tablet portion of the PDN. The display capability of the PDN device in Nathan is limited to the small LCD panel described above that is used to display the dynamic icons. Nathan does not provide a means for displaying the contents of the handwritten document in a first viewing area as recited in claim 11. Accordingly, the contents of the "dynamic icons" described in Nathan are not dynamically changed to reflect a change in the contents of a document in a first viewing area as recited in claim 11. Therefore, Applicants submit that Nathan fails to teach or suggest at least this limitation of claim 11.

Applicants submit that the deficiencies of Acrobat Reader and Hart are not cured by Nathan. Accordingly, even if the Examiner were to combine Nathan with Acrobat Reader and Hart, the combination would still fail to teach all of the elements of the claim 11. Furthermore, dependent claims 12-14, 17 and 18 are also in condition for allowance at least due to their dependence from independent claim 11.

Applicants further submit that independent claims 30 and 40 are also allowable for the same rationale as claim 11, and others. Furthermore, dependent claims 31-33, 36 and 37, which depend from independent claim 30 are also allowable at least due to their dependence from claim 30.

Accordingly, Applicants respectfully request that the rejection of claims 1-14, 17, 18, 30-33, 36, 37 and 40 be withdrawn.

Claims 15, 19, 34, 38, and 41-43

Claims 15, 19, 34, 38, and 41-43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Acrobat Reader, in view of U.S. Patent No. 6,339,437 to Nielsen et al. (hereinafter "Nielsen") and in further view of Hart and further in view of Nathan.

As demonstrated above, the pending claims are fully supported by the parent application which predates both Acrobat Reader and Nathan. Accordingly, the rejections based upon these references should be withdrawn.

Furthermore, Applicants submit that even if Acrobat Reader, Nathan, Hart and Nielson were considered to be proper references, claims 15, 34, 42 and 43 that depend either directly or indirectly from amended independent claims 11 and 30, are not taught or suggested by the combination of Acrobat Reader, Nathan, Hart and Nielson.

As demonstrated above, Acrobat Reader, Nathan, and Hart, either alone, or in combination, fail to suggest or disclose at least "dynamically changing the contents of the single thumbnail image to reflect a change in the *contents* of the document displayed in the first viewing area" as variously recited in claims 11 and 30 (emphasis added). Applicants submit that the deficiencies of Acrobat Reader, Nathan, and Hart are not cured by Nielson.

Applicants submit that Nielson merely discloses a graphical user interface that determines the amount of relevant information at a particular scrolling location in a document and changes one or more user perceptible system attributes such as color, sound, or an object (such as a smiley face) is displayed to reflect the amount of relevant information included in the particular scrolling location of the document. See Nielson, Abstract, and Fig. 5.

Applicants submit, however, that Nielson, like Acrobat Reader and Hart, is also silent as to "dynamically changing the contents of the single thumbnail image to reflect a change in the contents of the document in the first viewing area" as recited in claim 11. Nielson does not provide a thumbnail image, much less one that is dynamically updated to reflect a change in the structured document. Accordingly, even if Nielson were combined with Acrobat Reader, Nathan, and Hart, as suggested by the Examiner, the combination still fails to disclose or suggest each of the features recited in claim 11.

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Therefore, Applicants submit that claims 15 and 42, which depend from claim 11, and claims 34 and 43, which depend from claim 30, are also allowable at least due to their dependence from claims 11and 30, respectively.

Applicants further submit that independent claims 19, 38 and 41 are also allowable over Acrobat Reader, Nathan, Hart and Nielson for the same rationale as claim 11, and others. Furthermore, dependent claim 44, which depends from claim 41, is also allowable at least due to its dependence from claim 41.

Accordingly, Applicants respectfully request that the rejection of claims 15, 19, 34, 38, and 41-44 be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6100.

Respectfully submitted,

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Attachments
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